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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,553	09/30/2003	Erik J. van der Burg	3791	5764
21834 7590 06/10/2010 BECK AND TYSSER P.L.L.C. 2900 THOMAS AVENUE SOUTH SUITE 100 MINNEAPOLIS, MN 55416				
EXAMINER				
BLATT, ERIC D				
ART UNIT		PAPER NUMBER		
3734				
MAIL DATE		DELIVERY MODE		
06/10/2010		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary****Application No.**

10/674,553

**Applicant(s)**

VAN DER BURG ET AL.

**Examiner**

Eric Blatt

**Art Unit**

3734

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 February 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 38-43, 45-49, 56-61, 63, 66-71, 85-90, 120-126, 128-132, 134-138, 140-143, 145-151, 153-156, 158-169, 170-180 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Drattsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

Continuation of Disposition of Claims: Claims pending in the application are 1-5,38-43,45-49,56-61,63,66-71,85-90,120-126,128-132,134-138,140-143,145-151,153-156 and 158-180.

## **DETAILED ACTION**

### ***Claim Objections***

Claim 50 is objected to because of the following informalities: Applicant appears to have intended to cancel claim 50 in the amendment submitted February 26, 2010. Instead, claim 50 has been dropped entirely from the claim listing such that claim 49 is followed by an indication that claims 51-55 are cancelled. Examiner suggests correcting this to read that claims 50-55 are cancelled. Appropriate correction is required.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 38, 40, 55, 56, 58, 60, 61, 64 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 7 of **U.S. Patent No. 6,551,303**. Although the conflicting claims are not identical, they are not patentably distinct from each other because all the elements of the pending claims are found in claim 7 of the patent. The difference between claim 38, 40, 55, 56, 58, 60, 61, 64 of the application and claim 7 of the patent lies in the fact that the patent claim is more specific. For example, the patent claims a method of securing a porous membrane, encouraging endothelial cell growth, over an ostium of the atrial appendage by extending prongs into the atrial appendage wall and blocking the ostium with the membrane preventing thrombus from leaving. The instant application claims positioning a porous barrier adjacent an interior opening of the atrial appendage, and engaging at least on anchoring element with the interior surface of the atrial appendage to hold the device in place, wherein the anchoring element is connected to the barrier to hold the barrier adjacent the opening and prevent passage of material from the left atrial appendage. Thus, the invention of patented claim 7 is a species of generic invention in application claims. It has been held that the generic invention is anticipated by the species. See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since claims 40, 55, 56, 58, 60, 61, 64 are anticipated by claim 7 of the patent, it is not patentably distinct from patented claim 7.

Claims 45, 38, 56, 59, 60, 134, 136, 138 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 5 of **U.S. Patent No. 6,551,303**. Although the conflicting claims are not identical, they are

not patentably distinct from each other because all application claims are anticipated by claim 5 of the patent.

Claims 49, 56, 57, 58, 128m 170, and 176-178 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 14 of **U.S. Patent No. 6,551,303**. Although the conflicting claims are not identical, they are not patentably distinct from each other because all application claims are anticipated by claim 14 of the patent.

Claims 85, 89, 90, 120, 125, 145-148, 150, 151,153, 155, 156, 170-173 and 176-180 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 14 of **U.S. Patent No. 6,551,303**. Although the conflicting claims are not identical, they are not patentably distinct from each other because all application claims are anticipated by claims 5 and 18 of the patent.

Claims 38, 45, 48, 56, 58, 59, 134, 136, 138, 170, 171, 173, 176-180 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 3 of **U.S. Patent No 6,689,150**. Although the conflicting claims are not identical, they are not patentably distinct from each other because all application claims are anticipated by claims claim 3 of the patent.

Applicant (or the assignee of this application if the assignee has undertaken the prosecution of the application) is required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

There are numerous other co-pending applications and issued patents, which disclose and claim very similar and/or identical subject matter. In accordance with 37 CFR 1.105 and MPEP 704.11(a) subsection G, applicant (or the assignee) is respectfully requested to disclose all co-pending applications and related patents (please see the non-exhaustive list below of applications and issued patents that the USPTO believes may be related) and identify the specific claims of those applications and/or patents which may present double patenting issues with the instant application claims. This requirement is reasonably necessary to examination because, based on an initial review of the applications, there is a significant degree of overlap in claimed subject matter, thus requiring an analysis of commonality of claimed subject matter to determine patentability under 35 USC 101 double patenting and/or obviousness type double patenting. For example, claims 38, 40, 45, 49, 55-61, 64, 85, 89, 90, 120, 125, 134, 136, 138, 145-148, 150, 151, 153, 155, 156, 170-173 and 176-180 of application serial number 10/674,553 differ from claims 1, 5, 7, 14, 15, and 18 of application serial number 09/428,008 in only the fact that the patent claim is more specific. Thus, the invention of patented claims is a species of generic invention in application claims. It has been held that the generic invention is anticipated by the species. Because the applicant (or the assignee) is presumably far more cognizant of the contents of the claims in these applications than any Office staff, and has access to the source documents by which such comparison could be done better than within the Office, it is reasonable to require the applicant to provide the information needed to determine the commonality among the claims.

Should applicant (or the assignee) believe that Double Patenting exists, then applicant (or the assignee) is invited to file Terminal Disclaimers and/or amend the currently pending claims in the interest of expediting the prosecution of the current application. Applicant (or the assignee) should note that a terminal disclaimer is effective to overcome an obviousness type double patenting rejection, but will not overcome a "same type" double patenting rejection under 35 U.S.C. 101.

Non-exhaustive list of possible related co-pending applications and patents:

09/187,200  
09/399,521  
09/428,008  
09/614,091  
09/642,291  
09/825,647  
09/960,749  
10/033,371  
10/351,736  
10/426,107  
10/426,130  
10/441,718  
10/642,384  
10/810,990  
10/830,964  
10/997,804  
11/003,696  
11/009,392  
11/229,313  
11/401,199  
11/434,012  
11/607,638  
11/607,769

### ***Response to Arguments***

Applicant's arguments filed 2-26-2010 have been fully considered but they are not persuasive. Applicant argues that the claimed invention is patentably distinct from



the claimed invention of the Van Tassel patent since the Van Tassel is allegedly a barrier of the type permitting fluid exchange while filtering clots across the membrane while Applicant's invention allegedly does not provide this filtering function. Examiner first notes that neither of these supposedly distinguishing features are clearly expressed in the overlapping claims. Additionally, the device of Van Tassel is described in the Abstract as "a plug structure applied to the ostium of an atrial appendage for preventing blood flow and physical connection between an atrium of the heart and the associated atrial appendage." Van Tassel continues to explain that the barrier may be porous or non-porous. (Col. 2, Lines 2-3) From this disclosure, one skilled in the art would recognize that a plug that does not provide a filtering function is within the scope of the Van Tassel invention. Further, Applicant's claimed invention includes a porous barrier having a pore size up to about 0.04 inches. Such a barrier would seem to provide some degree of blood filtration. There does not appear to be a substantial difference between the respective claimed inventions with regard to the issue of blood filtration.

***Examiner's Note***

In the previous action, art rejections were only applied to claims 50, 55, 64, 91, 127, 133, 139, 144, 152 and 157 over US Patent No. 6,551,303 to Van Tassel et al. The present application is a continuation-in-part of application 09/187200, now US Patent No. 6,152,144 which was filed prior to the filing of the Van Tassel patent. Since claims 50, 55, 64, 91, 127, 133, 139, 144, 152 and 157 were found not to be supported in the parent application, however, Van Tassel applied as prior art against these claims.

Since claims 50, 55, 64, 91, 127, 133, 139, 144, 152 and 157 have been cancelled in the response filed 2-26-2010, the Van Tassel reference no longer applies as prior art against any of the remaining claims.

### ***Allowable Subject Matter***

Claims 1-5, 38-43, 45-49, 56-61, 63, 66-71, 85-90, 120-126, 128-132, 134-138, 140-143, 145-151, 153-156, 158-169, 170-180 are allowable if all double patenting issues are overcome. None of the prior art discloses a method for preventing passage of embolic material from an atrial appendage of a patient comprising the step of positioning a device adjacent the ostium, the interior opening of the atrial appendage, and into the atrial appendage, wherein the device prevents passage of embolic material from the atrial appendage.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Blatt whose telephone number is (571)272-9735. The examiner can normally be reached on Monday-Friday, 9:00 AM-6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on 571-272-4713. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/E. B./  
Examiner, Art Unit 3734

/TODD E. MANAHAN/  
Supervisory Patent Examiner, Art Unit 3734